

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

IVT.0021US

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on

April 27, 2006

Signature

Typed or printed
name

Jennifer Juarez

Application Number

09/930,827

Filed

August 15, 2001

First Named Inventor

Dominik J. Schmidt

Art Unit

2616

Examiner

Christopher P. Grey

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record. 42,117

Registration number

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

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Typed or printed name

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Telephone number

4/27/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Dominik J. Schmidt	§	Group Art Unit:	2616
		§		
Serial No.:	09/930,827	§		
		§	Examiner:	Christopher P. Grey
Filed:	August 15, 2001	§		
		§		
For:	RF Sniffer	§	Atty. Dkt. No.:	IVT.0021US
		§		

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant seeks pre-appeal review of the rejections of claims 1-7, 9 and 15-27. It is respectfully submitted that the rejections to pending claims 1-7, 9 and 15-27 are clearly erroneous and the burden of an appeal should be avoided.

Pending claims 1, 2 and 4-20 stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,625,889 (Chikkaswanny) in view of U.S. Patent No. 6,597,672 (Gustafsson). As to claim 1, neither of the references teach or suggest sniffing for available cellular frequency channels via a mobile station. As all claim elements are not taught or suggested by the references, the rejection is clearly erroneous and claim 1 is patentable. MPEP §2143.03.

In this regard, Chikkaswanny only discloses that a RF detection circuit of an overlay system detects for available frequency channels. However, this detection circuit is part of an overlay system, and not of a mobile station. *E.g.*, Chikkaswanny, col. 1, ln. 64 – col. 2, ln. 35. There is no basis in Chikkaswanny for performing the sniffing for available frequency channels in a mobile station. While the Examiner concedes that the sniffing performed in Chikkaswanny is in an overlay system and not a mobile station, the Examiner contends that the reference “more broadly, discloses the RF sniffer being implemented in a unit dedicated for the transmission of data.” Advisory Action (mailed April 12, 2006), p. 3. However, neither in the cited portions or

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Jennifer Juarez

anywhere else does Chikkaswanny teach or suggest RF sniffing in a transmission unit. Instead, Chikkaswanny teaches a separate module 16 that is a RF sniffer circuit. Clearly, this is not a data transmission unit, and it is certainly not a mobile station as recited by claim 1.

Furthermore, the Examiner fails to provide any teaching or suggestion in the references for modification of the operation of Chikkaswanny. This is especially so, as Chikkaswanny teaches the opposite of (i.e., teaches away from) mobile station location of the RF detection. MPEP §2141.02. That is, in Chikkaswanny the RF detection is closely associated with an overlay system so that the overlay system can use idle channels. Since it is the overlay system that is to use such channels, it defies the teaching of Chikkaswanny to contend that “any component within a cellular system may implement the sniffer detection.” Final Office Action (mailed January 30, 2006), p. 12. Nor does the secondary reference Gustafsson teach or suggest sniffing for available frequency channels whatsoever. For these reasons, the rejection of claim 1 is clearly erroneous.

Nor is there any motivation in the references to combine Chikkaswanny with Gustafsson to obtain the claimed subject matter recited in claim 1. In this regard, the purported motivation is to “optimize the utilization of the capacity within the network.” Final Office Action, p. 4. While this is one of the stated objects of Gustafsson, nowhere does either of the cited references anywhere teach or suggest how either the multichannel allocation of Gustafsson can be incorporated into the overlay system of Chikkaswanny, or how the RF detection of Chikkaswanny could be used by the system of Gustafsson. Instead, the Examiner, in the Advisory Action, merely states that because Chikkaswanny teaches its overlay system-based RF sniffer can be used in a TDMA environment, it is applicable to a TDMA network such as that disclosed by Gustafsson. Advisory Action, p. 3. However, “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). As such, there is no objective reason to combine the teachings of these references. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000). For all these reasons, claim 1 and the claims depending therefrom are patentable over the proposed combination.

The rejection of dependent claim 2 is further erroneous as neither of the references teaches or suggests communicating via the mobile station on a short-range radio channel. In this regard, the Examiner contends that Chikkaswanny teaches communicating over a voice channel

and “it would have been obvious to one of the ordinary skill in the art at the time of invention that a voice channel may be interpreted as a short range radio channel.” Final Office Action, p. 4. However, as disclosed by the specification, a short-range radio channel is different than a cellular channel (*e.g.*, Specification, 17-18), which is all that Chikkaswanny teaches or suggests. Neither of the cited references anywhere teaches or suggests short-range radio channel usage. Instead both are directed to cellular systems. Furthermore, the unsupported contention that “sniffer detection may also be used to detect available channels in short range channels in a short range environment” (Final Office Action, p. 12) is irrelevant to the claimed subject matter, as claim 2 recites communicating on a short-range radio channel, not any sniffer detection of such channels. Accordingly for these further reasons, the rejection of claim 2 and the claims depending therefrom are further erroneous.

The rejection of claim 5 is further erroneous as neither of the references teaches or suggests substituting at least one allocated cellular channel with a short-range radio channel if the cellular channel becomes unavailable. In this regard, the Examiner concedes that Chikkaswanny nowhere teaches or suggests such substitution. Further, as to Gustafsson all that is taught is moving an existing cellular channel from one location to another to differently allocate channels between different cellular devices. Nowhere however does Gustafsson teach or suggest substituting channels of different types (*i.e.*, short-range and cellular) as recited in claim 5 or its vice versa as recited by claim 6.

For similar reasons as to claims 2 and 5, the rejection of dependent claim 9 is further erroneous as nowhere does either of the references teach or suggest bonding a short-range radio channel and allocated cellular frequency channels. This is so, at least because neither of the references teach or suggest use of short-range radio channels. Furthermore, the Examiner contends that support for the proposed combination is that Gustafsson teaches moving a connection from one channel to another if needed (Final Office Action, p. 13). However, nowhere does this teach or suggest either bonding of channels generally, or specifically the recited bonding of a short-range radio channel with allocated cellular frequency channels.

Independent claim 16 is patentable, at least for the same failures discussed above regarding the claim 1 rejection. Further, neither of the references teach or suggest a mobile device that includes a reconfigurable processor core including both a long-range transceiver and a short-range transceiver and a radio frequency sniffer. Because the Examiner does not even

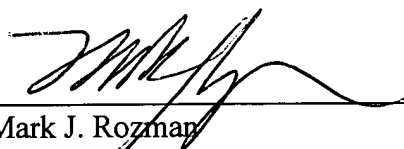
contend that either reference teaches or suggests a reconfigurable processor core as recited in the claim, there is no *prima facie* case of obviousness as to claim 16, and the rejection is clearly erroneous as to claim 16 and its dependent claims. MPEP §2142.

Dependent claims 21-27 are patentable at least for the same reasons as the independent claims from which they depend. Further, the Examiner has never set forth any basis for rejection of these claims, and certainly not a *prima facie* case. Without a *prima facie* case of unpatentability, the rejection violates PTO policy, and these claims are patentable. MPEP §2142 ("If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.").

Since these rejections are clearly violative of existing PTO policy, the need for an appeal should be avoided.

Respectfully submitted,

Date: April 27, 2006


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